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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,930	11/03/2003	Michael J. Iaconis	06181-918001	5058

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EXAMINER

LOWEN, ALYSSA

ART UNIT	PAPER NUMBER
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3711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/698,930

Applicant(s)

IACONIS ET AL.

Examiner

Alyssa M. Lowen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- * Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/4/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 10/4/06 is in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

2. The drawings were received on 10/4/06. These drawings are acceptable.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7-20, 22-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pin-Hung (4878875) and Suzuki (3199248). Pin-Hung discloses a toy having a body (Fig. 3), a motor or driving device (11) within the body (Fig. 4), an appendage (8) coupled to the body of the toy (Fig. 3) is actuated by the motor to move relative to the body along a first path (column 2 lines 10-25) that including movement of an end of the appendage along a non-circular path (column 4 lines 9-12) and a neck device (34) coupled to the body of the toy and actuated by the motor to move relative to the body along a third path (column 3 lines 2-8). A drive shaft operatively couples the motor to the appendage (Fig. 4). A cam or rotating device (31) receives the drive shaft such that rotation of the drive shaft rotates the cam (Fig. 4). An eccentric rod (82) to

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which the appendage connects extends from the cam (Fig. 6). A linkage rod (86) is coupled to the body of the toy and to a slot within the appendage and rotation of the cam causes the appendage to move along the first path (Fig. 6). The drive shaft further couples the motor to a neck device (Fig. 4). A head is connected to the neck device (Fig. 11), which includes a hinge (36) attached to the body such that the neck device is configured to rotate about the hinge as the neck device moves along the third path (Fig. 11). A follower (32) is attached to the neck device (Fig. 4) and coupled to the drive shaft by a cam (24) such that rotation of the drive shaft moves the follower in a periodic pattern and causes the neck device to move along the third path (column 3 lines 4-8). The toy has a controller in the form of a circuit (9) with a switch (101) located within the body and coupled to the motor (Fig. 12) and a sensor (10) connected to send a signal to the controller or circuit, which operates the motor in response to a signal from the sensor (column 2 lines 30-44). Another appendage shaped like the appendage is coupled to the body of the toy and positioned such that the ends of the appendages move in non-circular paths that are aligned with each other (Fig. 7). The toy also has a flexible skin cover (4) that resembles an animal's coat and surrounds the body and appendages of the toy (Fig. 1). The appendage is further actuated by the motor to rotate relative to the body about a first axis which runs horizontally through pin (96) and the neck device is further actuated by the motor to rotate relative to the body about a third axis that runs horizontally through hinge (36) making it parallel with the first axis. The device of Pin-Hung discloses the basic inventive concept, substantially as claimed with the exception of a moveable tail device. Suzuki discloses a toy animal device with

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appendages and a tail that move simultaneously with respect to one another (column 3 lines 23-26). The tail device (11) is coupled to the body of the toy (Fig. 3) and is actuated by a motor (2) to move relative to the body along a second path (Fig. 8). A drive shaft in the form of a crankshaft (3) couples the motor to the tail device (Fig. 3) and a connector piece (6) connects to a lower piece of a tail device to cause the tail to oscillate giving the appearance of a wagging tail (Fig. 3). It would have been obvious to one of ordinary skill in the art from the teaching of Suzuki to modify the device of Pin-Hung to include an oscillating tail in order to have a plurality of mechanisms moving in a timed relation so as to give an interesting and entertaining lifelike animation to the figure (column 3 lines 19-25). Regarding the limitation of a cam located on the drive shaft with a groove receiving the shaft of the connector piece, Pin-Hung discloses using cams on drive shafts having grooves formed between the lip of the pin on the cam and the cam itself that engage parts of the device such that rotation of the cam causes movement of the part (Fig. 6). The combination of Pin-Hung and Suzuki discloses a toy and a method of actuating a toy where the appendage and neck are actuated by a motor and rotated about a first and third axis, respectively, that are parallel to one another and a tail device coupled to the body of the toy and actuated by the motor is rotated relative to the body about a second axis that is perpendicular with the first axis (Fig. 2).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pin-Hung and Suzuki and further in view of DeCesare (5876273). The device of Pin-Hung and Suzuki discloses the basic inventive concept substantially as claimed with the exception of a pivot gear coupled to the body of the toy and including a post that couples to a slot

within the appendage, where gear teeth that mesh with gear teeth of the pivot gear extend from the cam such that rotation of the cam causes rotation of the pivot gear, which causes the appendage to move along the first path. DeCesare discloses a pivot gear (21) that includes a post for engaging a slot in an appendage and a cam or gear (22) engages the teeth the pivot gear (22) to cause the appendage to move along a first path (Fig. 2). The device of Pin-Hung and Suzuki uses a linkage rod coupled to the body as opposed to a pivot gear. However, these two elements are art-recognized functional equivalents in that they act to direct the movement of an appendage over a path. It would have been obvious to one of ordinary skill in the art to use a pivot gear to direct the movement of a part.

Response to Arguments

6. Applicant's arguments filed 10/4/06 have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Suzuki discloses making various parts of a toy move in order to give the toy a lifelike animation that would be entertaining to a user. Furthermore, it would also be within the general knowledge of a person of ordinary skill in the art to make an electromechanical toy with

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a movable tail as seen in the following patents to Chan (6273782), Iwaya (3164924), Takahashi (4810226) and Jung (5374216). In response to applicant's argument that adding a movable tail to the device of Pin-Hung would make it inoperable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Suzuki teaches having an electromechanical toy with a movable tail feature so as to create an interesting and entertaining toy that moves realistically.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Lowen whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AML


EUGENE KIM
SUPERVISORY PATENT EXAMINER